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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,201	04/21/2004	Hsi-Yu Chen	PMXP0177USA	3200
27765	7590	01/09/2006	EXAMINER	
NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION P.O. BOX 506 MERRIFIELD, VA 22116			ELLIS, SUEZU Y	
			ART UNIT	PAPER NUMBER
			2878	

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/709,201	CHEN, HSI-YU	
	Examiner	Art Unit	
	Suezu Ellis	2878	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMENDMENT

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 1 and 10, claim language recites "wherein no reflector is installed on the right side of the lens or is located above a first plane defined by a top end of the lens or below a second plane defined by a bottom end of the lens". Does applicant intend the "or" to be an "and" since arguments seem to directed as such? For examining purposes, the claim will be interpreted as written (with the "or").

Claims not specifically addressed are indefinite due to their dependency.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

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351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 14, 16 and 17 are rejected under 35

U.S.C. 102(b) as being anticipated by Tsai (US 5,883,727).

With respect to claims 1, 2, 4, 5, 10, 11, 13 and 14, Tsai discloses in Fig. 20 an image scanning apparatus with a light source (50), a housing, a lens (11) within the housing, a photosensor (CCD - 30) installed on a right side of the lens, a plurality of reflectors (mirrors) installed on the left side of the lens that forms a linear optical path to the photosensor, and there is no reflector on the right side of the lens. Fig. 20 further illustrates the linear optical path passes between two reflectors closest to the lens (223, 201g) and travels through the lens to the photosensor. Although Tsai fails to expressly disclose the lens focuses the light, Tsai does disclose the lens moves when the resolution changes, thus by the fact that the lens moves, it would have to focus the light onto the photosensor (col. 3, line 55 – col. 4, line 4).

With respect to claims 7, 8, 16 and 17, Fig. 20 illustrates four reflectors (mirrors), thus three reflectors are included.

Claims 1, 3, 5, 7, 10, 12, 14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Koseki et al. (US 4,751,582). Hereinafter, Koseki et al. will be referred to as Koseki.

With respect to claims 1, 3, 7, 10, 12 and 16, Koseki discloses in Fig. 1, a housing (12), a lens (56) installed inside the housing for focusing light, a photosensor

(40) located to the right of the lens, a plurality of reflectors (50, 52, 54) located on the left of the lens wherein no reflector is located to the right of the lens. Fig. 1 further illustrates two reflectors (54, 50) closest to the lens partially cover an edge of the lens but not a main part of the lens for allowing light to focus on the photosensor via the lens.

With respect to claims 5 and 14, Koseki further discloses the photosensor being a CCD sensor (col. 3, lines 28-29).

Claims 1, 4, 5, 7-10, 13, 14 and 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Lan (US 6,762,861).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

With respect to claims 1, 4, 5, 10, 13 and 14, Lan discloses in Fig. 5, a scanner module comprising a housing, light source (52), a lens (56) that focuses light installed inside the housing, a photosensor (CCD - 58) installed on a right side of the lens wherein the photosensor converts light outputted from the lens into digital signals, and a plurality of reflectors (mirrors – 53, 54) installed on a left side of the lens (i.e. left side of the lens) which reflects light inputted into the scanner module to form a linear optical

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path in order to guide light to the photosensor via the lens and no reflector is installed on the first side of the lens (i.e. to the right side of the lens).

With respect to claims 7-9 and 16-18, Fig. 5 further illustrates the scanning module comprising five mirrors (reflectors), thus the module inherently comprises of three and four mirrors.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 6, 9, 12, 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai.

With respect to claims 3 and 12, Tsai addresses all the limitations of claims 1 and 10, however fails to expressly disclose the two reflectors closest to the lens are capable of partially covering an edge ring of the lens but not a main part of the lens for allowing light to focus on the photosensor via the lens. It would have been an obvious design choice to place two reflectors closest to the lens to partially cover an edge ring of the lens in order to make the system more compact.

With respect to claims 6 and 15, Tsai addresses all the limitations of claims 1 and 10, however fails to expressly disclose the photosensor being a CMOS. However, it

would have been obvious to make the photosensor a CMOS since CMOS sensors are easier to produce and are more cost effective than CCDs.

With respect to claims 9 and 11, Tsai addresses all the limitations of claims 1 and 10, however fails to expressly disclose the inclusion of five reflectors. It would have been an obvious design choice to include any number of reflectors that are needed to ensure proper imaging on the detector and to make the system more compact.

Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being obvious over Lan.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

With respect to claims 6 and 15, Lan addresses all the limitations of claims 1 and 10, however fails to expressly disclose the photosensor being a CMOS. However, it would have been an obvious design choice to make the photosensor a CMOS since CMOS sensors are easier to produce and are more cost effective than CCDs.

Response to Arguments

Applicant's arguments filed December 14, 2005 have been fully considered but they are not persuasive.

With respect to claims 1 and 10, Applicant argues that Tsai and Lan fail to disclose a photosensor installed on a right side of a lens, a plurality of reflectors installed on a left side of the lens wherein no reflector is positioned on the right side of the lens. However, the Office disagrees. The claims fail to clearly distinguish the left side and right side since there are no reference to define what is considered "left" and what is considered "right". The "left side" and "right side" are determined by how a figure is viewed. If the figure is viewed upside down, then what was once on the left of the lens can be interpreted as being to the right of the lens.

Applicant further argues that Tsai and Lan fail to disclose being located between the top end and the bottom end of the lens. However, the claim recites "wherein no reflector is installed on the right side of the lens or is located above a first plane defined by a top end of the lens or below a second plane defined by a bottom end of the lens". The claim does not limit the reflectors to be located in a plane between the top and the bottom of the lens.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Telephone/Fax Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suez Ellis whose telephone number is (571) 272-2868. The examiner can normally be reached on 8:30am-5pm (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Stephane B. Allen
Primary Examiner